

AS

Notice of Allowability	Application No.	Applicant(s)	
	10/056,212	MULLIGAN	
	Examiner	Art Unit	
	John S. Chu	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE filed 1/22/04.
2. ☒ The allowed claim(s) is/are 1,3-5,7,8,13-15,18,20-23,34,37,39 and 50-72.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>4/7/04 and 4/16/04</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

John S. Chu
Primary Examiner
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EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Sean Mahoney on April 7, 2004 and April 16, 2004.

The application has been amended as follows:

Claim 34, line 8 after "radiation;" insert - - an acid generator; a colorant;- - . This amendment inserts the limitations of claim 38 into claim 37 further defining the method wherein the composition now has the acid generator and colorant not recited in KURISAKI et al.

Cancel claim 36.

Claim 37, line 8 after "radiation;" insert - - an acid generator; a colorant;- - . This amendment inserts the limitations of claim 38 into claim 37 further defining the method wherein the composition now has the acid generator and colorant not recited in KURISAKI et al prior art.

Cancel Claim 38.

Claims 64 – 71, line 1 replace "36" with - - 34- - . This amendment makes the claims dependent on independent claim 34 and removes the dependency on cancelled claim 36.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance: The claimed invention is drawn to the following:

1. (Currently amended) A positive working imageable composition, comprising:
- ~~an ink-receptive~~ a hydroxyfunctional resin comprising a covalently bound radiation sensitive group capable of increasing the solubility of said imageable composition in an alkaline developer upon exposure to radiation;
 - an acid generator;
 - a colorant; and
 - an isocyanate crosslinking agent.

34. (Currently Amended) An imageable element comprising:
- a substrate comprising a hydrophilic surface; and
 - a positive working imageable composition coated on a surface of said substrate, said composition comprising:
 - ~~a~~ an ink-receptive hydroxyfunctional resin comprising a covalently bound radiation sensitive group capable of increasing the solubility of said imageable composition in an alkaline developer upon exposure to radiation; and
 - an isocyanate crosslinking agent.

37. (Currently Amended) A method of producing an imaged element comprising the steps of:
- providing an imageable element comprising a substrate comprising a hydrophilic surface and a positive working imageable composition coated on ~~a~~ the surface of said substrate, wherein said imageable composition comprises:
 - ~~a~~ an ink-receptive hydroxyfunctional resin comprising a covalently bound radiation sensitive group capable of increasing the solubility of said imageable composition in an alkaline developer upon exposure to radiation; and
 - an isocyanate crosslinking agent;
 - heating said imageable element at a temperature and length of time sufficient to produce a crosslinked imageable element;
 - imagewise exposing said crosslinked imageable element to radiation to produce an imagewise exposed element having exposed and unexposed regions; and
 - ~~contacting said imagewise exposed element and a developer to remove~~ removing the exposed regions of said imageable composition and thereby to produce said imaged element.

The claims, as now amended by inserting the acid generator and the colorant ingredients into claims 34 and 37 of the RCE received March 15, 2004, are not disclosed in the prior art

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reference to KURISAKI et al., thus the Final rejection as given in the Office action mailed November 24, 2003 is **withdrawn**.

Upon updating the search, newly cited reference to SCHUPP et al is cited to disclose a positive working photosensitive recording material wherein the copolymer comprises an o-nitrobenzyl acrylate and other comonomers, an isocyanate crosslinking ingredient and a colorant such as a Sudan Deep Black BB (Examples 1-7). The reference lacks a teaching for the acid generator as recited in claim 1 and amended claims 34 and 37.

Further because none of the references of record disclose or teach the recited positive working imageable composition comprising the claimed radiation sensitive group covalently bound to a hydroxyfunctional resin, an acid generator, a colorant and an isocyanate crosslinking agent of claim 1 or the imageable element of claim 34 and the method of claim 37, claims 1, 3-5, 7, 8, 13-15, 18, 20-23, 34, 37, 39, 50-72 are seen as allowable and passed to issue.

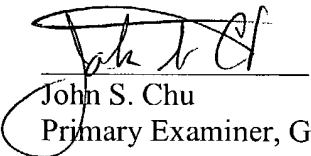
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

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The fax phone number for the USPTO is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1700.



John S. Chu
Primary Examiner, Group 1700

J.Chu
April 16, 2004